

REMARKS

Claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-95 are pending in this application. Claims 44, 50, 56, 57, 64, 71, 72, 79, 86, 88, 90, and 92-95 are amended herein. Support for the amendments to the claims may be found in the claims is filed originally, and at page 9, lines 1-14 and page 33, lines 1-8 of the specification. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. The final Office Action asserts in section 6, at page 12, lines 14, 15, and 16, that:

Said limitation simply recites allowing a client computer to select articles from a summary of articles and transmitting an article to said client computer from said selection.

This is submitted to be without basis. The independent claims, for example, recited formerly inter alia receiving "a specification from the client computer in response to the summary," rather than simply "allowing a client computer to select articles from a summary of articles and transmitting an article to said client computer from said selection," as asserted in the final Office Action. No specification is received "from the client computer in response to the summary" in McCaskey.

In McCaskey, rather, a subscriber *first* specifies a plurality of selection criteria for news topics for electronic mail presentation, and *then* news information extracted according to subscriber selection criteria is sent to the subscriber, as discussed more fully below.

The final Office Action goes on to assert in section 6, at page 12, line 16 and 17, that:

Applicant's specification does not have support for receiving a plurality of electronic articles by selecting a single article in a summary.

The specification does, however, describe receiving "a specification from the client computer in response to the summary," as recited formerly in the independent claims, at inter alia page 9, lines 1-20, and page 51, lines 3-14.

The final Office Action asserts further in section 6, at page 12, lines 18-21, continuing at page 13, line 1, that:

McCaskey teaches providing a means for a subscriber to specify a plurality of selection criteria (i.e. plurality of articles) for news topic (i.e. summary), extracting

new information according to subscriber selection criteria (i.e. plurality of articles) and preparing an electronic mail message of said news information (see McCaskey col 17, paragraph 62).

Letting a subscriber specify a plurality of selection criteria for news topics for electronic mail presentation, after which news information extracted according to subscriber selection criteria is sent to the subscriber, however, does not amount to receiving "a specification from the client computer in response to the summary," as recited formerly in the independent claims. Moreover, a "plurality of articles" does not amount to "selection criteria," contrary to the assertion in the final Office Action. Nor is McCaskey extracting *new* information according to a plurality of articles, contrary to the assertion in the final Office Action. The subscriber in McCaskey, rather, receives a summary of the selected article, along with a URL to *that* complete article, when the subscriber selects an article.

The final Office Action asserts further in section 6, at page 13, lines 1-4, that:

Also, McCaskey teaches transmitting electronic mail summaries of news delivered to subscribers (see paragraph 21), where subscribers are hyperlinked to the complete histories of said news summaries (see paragraphs 142-143) when said subscribers select an article in said summaries.

Transmitting electronic mail summaries of news delivered to subscribers, however, does not amount to receiving "a specification from the client computer in response to the summary," as recited formerly in the independent claims, even if subscribers were hyperlinked to the complete histories of the news summaries.

McCaskey, moreover, combines news article text and news images with Web page templates to produce a Web-readable news publication, which appears each day in synchronization with the daily paper news publication. In particular, as described at paragraph [0021]:

This invention receives daily data feeds of news article text and news images, extracts from the articles both the text content and the formatting directives used in the newspaper layout, restructures the formatting directives into organizing directives for Web pages, stores the text content and the organizing directives in a database, stores the news images in an image library, retrieves the text content and organizing directives from the database in a pattern which may be made significantly different from the pattern in which they were stored, and combines them with Web page templates to produce a Web-readable news publication. The Web-readable publication appears each day in synchronization with the daily paper news publication.

Since McCaskey combines news article text and news images with Web page templates to produce a Web-readable news publication, McCaskey is not receiving "a specification from the client computer in response to the summary," as recited formerly in the independent claims.

McCaskey, moreover, incorporates a URL pointing to the story Web page holding the complete story in order to facilitate further reading for each one of the topic's stories. In particular, as described at paragraph [0142]:

In order to facilitate further reading for each one of the topic's stories, program 133 also incorporates in headline 705d a URL pointing to the story Web page holding the complete story.

Since McCaskey incorporates a URL pointing to the story Web page holding the complete story in order to facilitate further reading for each one of the topic's stories, McCaskey is not receiving "a specification from the client computer in response to the summary," as recited formerly in the independent claims.

McCaskey, moreover, incorporates a URL pointing to the story Web page holding the complete story in order to facilitate further reading for each one of the topic's stories. In particular, as described at paragraph [0142]:

In order to facilitate further reading for each one of the topic's stories, program 133 also incorporates in headline 705d a URL pointing to the story Web page holding the complete story.

Since McCaskey incorporates a URL pointing to the story Web page holding the complete story in order to facilitate further reading for each one of the topic's stories, McCaskey is not receiving "a specification from the client computer in response to the summary," as recited formerly in the independent claims.

The final Office Action asserts further in section 6, and page 13, lines 7-10, that:

The Examiner answers that in McCaskey, everytime that a subscriber selects an article from the summary of articles transmitted to said susbscriber, said subscriber is selecting or specifying the article that said subscriber wants to received detailed information (see paragraphs 179).

Selecting or specifying the article that the subscriber wants to received detailed information about, however, does not amount to receiving "a specification from the client computer in response to the summary," as recited formerly in, for example, the independent claims.

McCaskey, rather, wants to provide a low-cost, attractive, easy-to-use, and easy-to-maintain news publication on the World Wide Web, at no cost to the reader. In particular, as described at paragraph [0021]:

The invention's combination of features and capabilities provides for a low-cost, attractive, easy-to-use, and easy-to-maintain news publication on the World Wide Web, at no cost to the reader.

Since McCaskey wants to provide a low-cost, attractive, easy-to-use, and easy-to-maintain news publication on the World Wide Web, at no cost to the reader, McCaskey is not receiving "a specification from the client computer in response to the summary," as recited formerly in the independent claims.

The final Office Action asserts further in section 6, at page 13, lines 13-16, that:

The Examiner answers that everytime that a subscriber in McCaskey selects an article from a summary of articles transmitted to said subscriber via electronic mail, said subscriber is receiving a plurality of articles based upon said selection (see paragraph .179).

This is submitted to be without basis. The subscriber in McCaskey, rather, receives a summary of the selected article, along with a URL to the complete article, when the subscriber selects an article, not a plurality of articles, contrary to the assertion of the final Office Action.

The final Office Action asserts further in section 6, at page 14, lines 1-4, that:

The Examiner answers Applicant's specification only has support for selecting an article in a summary of articles and receiving a detailed information of said selected article (see specification page 52).

The specification, to the contrary, describes receiving "a specification from the client computer in response to the summary," as recited formerly in, for example, the independent claims at, inter alia page 9, lines 1-20, and page 51, lines 3-14.

Nevertheless, in the interest of compact prosecution only, and not for any reason of patentability, claims 44, 50, 56, 57, 64, 71, 72, 79, 86, 88, 90, and 92-95 have been amended to replace the word "specification" with the word "specified information." Even if, as asserted in the final Office Action, a subscriber in McCaskey could specify a plurality of selection criteria (i.e. plurality of articles) for news topic (i.e. summary), extracting new information according to subscriber selection criteria (i.e. plurality of articles) and preparing an electronic mail message of said news information, that still does not amount to receiving "specified information from the client computer in response to the summary," as recited substantially in the independent claims.

The final Office Action asserts further in section 6, at page 14, lines 4, 5, and 6, that:

Applicant's specification does not have support for selecting a single article from a summary of articles and receiving a plurality of articles from said single article selection.

The specification does, however, describe extracting "a plurality of electronic articles from the article database based on the specification," as recited formerly in the independent claims, at inter alia page 18, lines 20-25, continuing at page 19, lines 1-19. Neither McCaskey nor Reilly describe extracting "a plurality of electronic articles from the article database based on the specification," as recited formerly in the independent claims.

Finally, the final Office Action asserts in section 6, at page 14, lines 6-10, that:

Therefore, the limitation "the specification specifying which electronic article is selected by a user of the client computer and extracting a plurality of electronic articles from the article database based on the specification" is interpreted in light of the specification as simply obtaining detailed information from a summary of articles when a subscriber selects an article in said summary of articles.

This is submitted to be without basis. Since neither McCaskey nor Reilly describe extracting "a plurality of electronic articles from the article database based on the specification," as recited formerly in the independent claims, the independent claims are submitted to be in condition for allowance.

Further reconsideration is thus requested.

Claim Rejections - 35 U.S.C. § 112:

Claims 93, 94, 95 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The rejection is traversed.

The final Office Action asserts in section 3, and page 2, that:

Applicant's specification does not explain how by replying a keyword in an e-mail there is a sorting of information.

The specification, to the contrary, describes the keyword included in the reply electronic mail being extracted, and the contents of the homepage being sorted based on the extracted keyword. In particular, as described at page 43, lines 1-6:

The keyword stored in the "keyword" item in the news category file by user 115 is then extracted, based on the received display instruction information (step S2653), and based on the extracted keyword, the contents of the homepage extracted in step S2652 is sorted (step S2654).

Claims 93, 94, and 95 are thus submitted to meet the written description requirement within the meaning of 35 U.S.C. § 112, first paragraph. Withdrawal of the rejection as earnestly solicited.

Claim Rejections – 35 U.S.C. § 102:

Claims 56, 71, and 86 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application No. 2002/0152245 to McCaskey (hereinafter "McCaskey"). The rejection is traversed to the extent it might apply to the claims as amended. Withdrawal of the rejection as earnestly solicited.

The third clauses of claims 56, 71, and 86 recite substantially:

A receiving unit that receives specified information from the client computer in response to the summary.

McCaskey neither teaches, discloses, nor suggests, "a receiving unit that receives specified information from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86. No specified information is received "from the client computer in response to the summary" in McCaskey.

In McCaskey, rather, a subscriber *first* specifies a plurality of selection criteria for news topics for electronic mail presentation, and *then* news information extracted according to subscriber selection criteria is sent to the subscriber. In particular, as recited in claim 62:

62. The method of claim 61 wherein the step of selecting and sending news information to news subscribers via electronic mail, further comprises: providing a means for a plurality of subscribers to request electronic mail presentation of news information, providing a means for a subscriber to specify a plurality of selection criteria for news topics for electronic mail presentation, extracting news information according to subscriber selection criteria, preparing an electronic mail message for each subscriber requesting electronic mail presentation of news information, and transmitting the electronic mail messages to all subscribers requesting electronic mail presentation of news information.

Since, in McCaskey, a subscriber specifies a plurality of selection criteria for news topics for electronic mail presentation, after which news information extracted according to subscriber selection criteria is sent to the subscriber, McCaskey is not receiving "specified information from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86.

Furthermore, in McCaskey, statistics concerning electronic mail users and their selections of news topics are combined with subscriber preferences stored in electronic mail user's database 460 to *create* statistics for the administrator 151 to use. No specified information is solicited from the subscriber at all. In particular, as described at paragraph [0176]:

Administrator 151 also uses a set of statistics Web pages 171 to review statistics concerning electronic mail users and their selections of news topics. Statistics

program 351 combines the set of topics from topic table 405 in editorial database 400 with subscriber preferences stored in electronic mail users database 460 to create its statistics for administrator use.

Since no specified information is sent "from the client computer in response to the summary" in McCaskey, McCaskey is not receiving "specified information from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86.

Moreover, in McCaskey, the news selections specified by each user are maintained in the electronic mail user's database 460, at a separate website. In particular, as described at paragraph [0177]:

The electronic mail subscriber controls his or her own subscription through Web access to a separate Website, which maintains the electronic mail address and the news selections specified by each user in the electronic mail users database 460.

Since, in McCaskey, the news selections specified by each user are maintained in the electronic mail users database 460, at a separate website, McCaskey is not receiving "specified information from the client computer in response to the summary," as recited substantially in claims 56, 71, and 86.

The fourth clauses of claims 56, 71, and 86 recite substantially:

An extracting unit that extracts a plurality of electronic articles from the article database based on the specified information.

McCaskey neither teaches, discloses, nor suggests "an extracting unit that extracts a plurality of electronic articles from the article database based on the specified information," as recited substantially in claims 56, 71, and 86. In McCaskey, rather, the news electronic mail program 358 generates news electronic mail messages 178 for each user from the contest Web pages 173, the announcement Web pages 174, the weather Web pages 175, and all current day headline information 180 created for electronic mail use by publish program 133. None of the statistics concerning electronic mail users and their selections of news topics that were reviewed by the administrator 151 are used to generate news electronic mail messages 178 for the users. In particular, as described at paragraph [0179]:

News electronic mail program 358 reads contest Web pages 173, announcement Web pages 174, weather Web pages 175, and all current day headline information 180 created for electronic mail use by publish program 133. News electronic mail program 358 then reads the list of electronic mail subscribers stored in electronic mail users database 460, generates news electronic mail messages 178 for each user, and mails the messages out to the users 3 via the World Wide Web 40.

Since, in McCaskey, the news electronic mail program 358 generates news electronic mail messages 178 for each user from the contest Web pages 173, the announcement Web pages 174, the weather Web pages 175, and all current day headline information 180 created for electronic mail use by publish program 133, McCaskey is not extracting "a plurality of electronic articles from the article database based on the specified information," as recited substantially in claims 56, 71, and 86. Claims 56, 71, and 86 are submitted to be allowable. Withdrawal of the rejection of claims 56, 71, and 86 is earnestly solicited.

Claim Rejections – 35 U.S.C. § 103:

Claims 44, 46-50, 52-55, 57, 59-64, 66-70, 72, 74-79, 81-85 and 87-95 are rejected under 35 U.S.C. §103(a) as being unpatentable over McCaskey in view of U.S. Patent No. 5,740,549 to Reilly (hereinafter "Reilly").

The third clauses of claims 44, 50, 57, 64, 72, and 79 recite substantially:

Receiving specified information from the client computer in response to the summary.

McCaskey neither teaches, discloses, nor suggests "receiving specified information from the client computer in response to the summary," as discussed above with respect to the rejection of claims 56, 71, and 86. Reilly does not either, and thus cannot make up for the deficiencies of McCaskey with respect to claims 44, 50, 57, 64, 72, and 79.

In Reilly, rather, the subscriber sets up a profile, including categories of topics of interest, and the system, not the subscriber, selects the articles to be displayed on the subscriber's computer accordingly. In particular, as described at column 2, lines 49-53:

Another goal of the present invention is provide each subscriber with the ability to set up and change a user profile indicating categories and subcategories of topics which are of interest and not of interest to the subscriber, and to select the news stories displayed on the subscriber's computer accordingly.

Since, in Reilly, the system, not the subscriber, selects the articles to be displayed on the subscriber's computer, Reilly is not "receiving specified information from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and 79.

Furthermore, even if the user profile set up by the subscriber in Reilly were considered to be equivalent to the recited specified information, it still would not be received "from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and

79. Rather, in Reilly, the summary, i.e. the news stories displayed on the subscriber's computer, would be selected to suit the topics listed in the subscriber's *profile*, not the other way around.

Similarly, even if the primary components, i.e. the headlines of the news stories in Reilly were considered to be equivalent to the recited summary, and displaying the secondary component of a news story in Reilly upon a subscriber's request was considered to be equivalent to the recited specified information, the subscriber's request would still not be received "from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and 79.

Rather, in Reilly, each news item displayed in the center section 248 of the data viewer's display *includes* both the primary and secondary portions of the news item. Thus, *both* the primary *and* the secondary components of each news story are already *on* the client computer, and there is no need to send back to the information server for the secondary component in order to display that as well. In particular, as described at column 13, lines 49-60:

Each news item displayed in the center section 248 of the data viewer's display includes both the primary and secondary portions of the news item, thereby providing the subscriber in most instances with access to a fuller version of the news item than was shown by the screen saver. In the case of very short news items, the entire news item may be contained in its primary component. Furthermore, in client computers with very limited hard disk space available for storing news items, as indicated by the user profile 194 for the client computer, the secondary component of news items may not be stored in the local information database in order to conserve disk space.

Since, in Reilly, each news item displayed in the center section 248 of the data viewer's display includes both the primary and secondary portions of the news item, Reilly is not "receiving specified information from the client computer in response to the summary," as recited substantially in claims 44, 50, 57, 64, 72, and 79.

The fourth clauses of claims 44, 50, 57, 64, 72, and 79 recite substantially:

Extracting a plurality of electronic articles from the article database based on the specified information.

McCaskey neither teaches, discloses, nor suggests "extracting a plurality of electronic articles from the article database based on the specified information," as discussed above with respect to the rejection of claims 56, 71, and 86. Reilly does not either, and thus cannot make up for the deficiencies of McCaskey with respect to claims 44, 50, 57, 64, 72, and 79.

In Reilly, rather, even if the primary components, i.e. the headlines of the news stories were considered to be equivalent to the recited summary, and displaying the secondary

component of a news story in Reilly upon a subscriber's request were considered to be equivalent to the recited specified information, a subscriber may still only request that the secondary component of a news article be *displayed*, as discussed above, not extract "a plurality of electronic articles from the article database based on the specified information," as recited substantially in claims 44, 50, 57, 64, 72, and 79. Thus, even if McCaskey and Reilly were combined, as proposed in the final Office Action, claims 44, 50, 57, 64, 72, and 79 would not result. Claims 44, 50, 57, 64, 72, and 79 are thus submitted to be allowable. Withdrawal of the rejection of claims 44, 50, 57, 64, 72, and 79 is earnestly solicited.

Claims 46-49, 87 and 88; 52-55 and 93; 59-63, 89, and 90; 66-70 and 94; 74-78, 91, and 92; and 81-85 and 95 depend from claims 44, 50, 57, 64, 72, and 79, respectively, and add further distinguishing elements. Claims 46-49, 87 and 88; 52-55 and 93; 59-63, 89, and 90; 66-70 and 94; 74-78, 91, and 92; and 81-85 and 95 are thus also submitted to be allowable. Withdrawal of the rejection of claims 46-49, 87 and 88; 52-55 and 93; 59-63, 89, and 90; 66-70 and 94; 74-78, 91, and 92; and 81-85 and 95 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-95 are allowable over the cited references. Allowance of all claims 44, 46-50, 52-57, 59-64, 66-72, 74-79, and 81-95 and of this entire application is therefore respectfully requested.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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